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Docket No.: 016762.0227-US00  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Calvin H. Fei, et al.

Application No.: 09/925,972

Filed: August 10, 2001

For: METHOD AND APPARATUS FOR  
CONDUCTING TRANSACTIONS ON AN  
AUTOMATED TELLER MACHINE

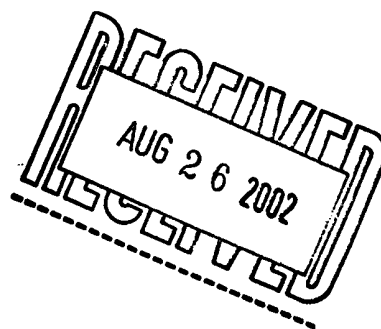
Group Art Unit: 2673

Examiner: Not Yet Assigned

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**TRANSMITTAL LETTER**

Commissioner for Patents  
Washington, DC 20231

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:

1. Information Disclosure Statement;
2. Form PTO/SB/08;
3. International Search Report;
4. 17 cited documents; and
5. Return receipt postcard.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in

Application No.: 09/925,972

2

Docket No.: 016762.0227-US00

this application by this firm) to our Deposit Account No. 50-0740, under Docket No.  
016762.0227-US00. A duplicate copy of this paper is enclosed.

Dated: August 20, 2002

Respectfully submitted,

By

  
Grady L. White

Registration No.: 40,874

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Docket No.: 016762.227-US00  
(PATENT)

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Calvin H. Fei, et al.

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**Information Disclosure Statement**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Listed on accompanying Form PTO/SB/08 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO/SB/08 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior

art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith. It is further understood that the Examiner will consider information that had been cited by or submitted to the U.S. Patent and Trademark Office in a prior application relied on under 35 U.S.C. § 120. 1138 OG 37, 38 (May 19, 1992).

- ☒ 1. This Information Disclosure Statement is being filed within three months of the U.S. filing date OR before the mailing date of a first Office Action on the merits. No statement under 37 C.F.R. § 1.97(e) or fee is required.
- ☐ 2. This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection or Notice of Allowance.
  - ☐ a. I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
  - ☐ b. I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

- ☐ c. Attached is our Check No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_ in payment of the fee under 37 C.F.R. § 1.17(p).
- ☐ 3. This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. It is hereby requested that the Information Disclosure Statement be considered. Attached is our Check No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_ in payment of the fee under 37 C.F.R. § 1.17(i).
- ☐ a. I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ 4. Relevance of the non-English language document(s) is discussed in the present specification.
- ☒ 5. The document(s) was/were cited in a corresponding foreign application. An English language version of the foreign search report is attached for the Examiner's information.
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below:
- ☐ 7. The Examiner's attention is directed to co-pending U.S. Patent Application No. \_\_\_\_\_, filed \_\_\_\_\_, which is directed to related technical subject matter. The identification of this U.S. Patent Application is not to be construed as a

waiver of secrecy as to that application now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited application and the art cited therein during examination.

- ☐ 8. Copies of the documents were cited by or submitted to the Office in Application No. \_\_\_\_\_, filed \_\_\_\_\_, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO/SB/08, and to indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 50-0740, referencing Docket No. 016762.227-US00.

Dated: August 20, 2002

Respectfully submitted,

By

  
Grady L. White

Registration No.: 40,874

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PTO/SB/08A (10-01)

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| <b>Substitute for form 1449A/PTO</b><br><br><b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br>(use as many sheets as necessary) |   |    | <b>Complete if Known</b> |                        |                  |
|   |   |    | Application Number       | 09/925,972             |                  |
|   |   |    | Filing Date              | August 10, 2001        |                  |
|   |   |    | First Named Inventor     | Calvin H. Fei          |                  |
|   |   |    | Art Unit                 | 2673                   |                  |
|   |   |    | Examiner Name            | Not Yet Assigned       |                  |
| Sheet   | 1 | of | 2                        | Attorney Docket Number | 016762.0227-US00 |

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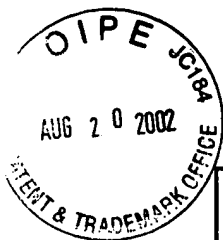
| U.S. PATENT DOCUMENTS |                          |  |                                |  |  |
|-----------------------|--------------------------|--|--------------------------------|--|--|
| Examiner<br>Initials* | Cite<br>No. <sup>1</sup> | Document Number                          | Publication Date<br>MM-DD-YYYY | Name of Patentee or Applicant<br>of Cited Document | Pages, Columns, Lines,<br>Where Relevant<br>Passages or Relevant<br>Figures Appear                   |
|                       |                          | Number-Kind Code <sup>2</sup> (if known) |                                |  |  |
|                       | A                        | US 5,473,143 A                           | 12-05-1995                     | VAK et al.   | col. 1, line 65 through<br>col. 3, line 9  |
|                       | B                        | US 5,305,195 A                           | 04-19-1994                     | MURPHY   | Abstract, col. 1, lines 35-<br>51; col. 3, lines 16-47;<br>col. 4, line 61 through<br>col. 5, line 2 |
|                       | C                        | US 5,619,558 A                           | 04-08-1997                     | JHEETA   | entire document  |
|                       | D                        | US 5,870,724 A                           | 02-09-1999                     | LAWLOR et al.                                      | entire document  |
|                       | E                        | US 5,933,811 A                           | 08-03-1999                     | ANGLES et al.                                      | entire document  |
|                       | F                        | US 6,085,177 A                           | 07-04-2000                     | SEMPLE et al.                                      | entire document  |
|                       | G                        | US 6,149,055 A                           | 11-21-2000                     | GATTO  | entire document  |
|                       | H                        | US 6,144,944 A                           | 11-07-2000                     | KURTZMAN, II, et al.                               | col. 2, lines 22-47  |

| FOREIGN PATENT DOCUMENTS |                          |   |                                |  |  |                |
|--------------------------|--------------------------|---|--------------------------------|--|--|----------------|
| Examiner<br>Initials*    | Cite<br>No. <sup>1</sup> | Foreign Patent Document   | Publication Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines,<br>Where Relevant<br>Passages or Relevant Figures<br>Appear | T <sup>6</sup> |
|                          |                          | Country Code <sup>3</sup> -Number <sup>4</sup> -Kind<br>Code <sup>5</sup> ( <i>if known</i> ) |                                |  |  |                |
|                          | I                        | WO 00/75889 A2  | 12-14-2000                     | PEREZ  | entire document  |                |
|                          | J                        | US 2001/0029528 A1  | 10-11-2001                     | COUTTS et al.                                      | entire document  |                |

|                       |  |                    |  |
|-----------------------|--|--------------------|--|
| Examiner<br>Signature |  | Date<br>Considered |  |
|-----------------------|--|--------------------|--|

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See attached Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the application number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.



PTO/SB/08B (10-01)

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|   |   |    |   | Group Art Unit           | 2673             |
|   |   |    |   | Examiner Name            | Not Yet Assigned |
| Sheet   | 2 | of | 2 | Attorney Docket Number   | 016762.0227-US00 |

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| OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS |                          |  |                |
|---|--------------------------|--|----------------|
| Examiner<br>Initials                              | Cite<br>No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T <sup>2</sup> |
|   | K                        | LEE, W.A., "Customized Ads, Coupons Coming to ATMs?" American Banker, 05 September 2000, Vol. 169, No. 166, p. 8, see entire article.  |                |
|   | L                        | STOCK, H., "Coming Next to Your Local Bank: ATM's That Allow Internet Access?" American Banker, 09 March 2000, Vol. 165, No. 47, p. 20A, see especially ninth and tenth paragraphs, and final two paragraphs.  |                |
|   | M                        | ANON., "The Year of the Thin Client," Cards International, 11 December 1996, Vol. 169, p. 7, see last 12 paragraphs.   |                |
|   | N                        | EDWARDS, R., "ATMs -- the Hot New Media Buy," ABA Banking, March 1999, Vol. 91, No. 3, pp. 58-60, see entire article.  |                |
|   | O                        | ANON., "Drilling for Customer Data on ATMs Made Easier," Bank Network News, 09 June 1999, see entire article.  |                |
|   | P                        | REDMAN, R., "Wells Fargo to Web-enable 6,300 Machines," Bank Systems and Technology, July 2000, Vol. 37, No. 7, pp. 18, see especially fourth full paragraph of text.  |                |
|   | Q                        | ANON., "ATM Prospectors Seek Data Mining Gold," Bank Network News, 13 January 1998, see final paragraph.   |                |

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